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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,991	03/02/2004	Mikhail Lotvin		1319

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EXAMINER

BOVEJA, NAMRATA

ART UNIT PAPER NUMBER

3622

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/790,991

Applicant(s)

LOTVIN ET AL.

Examiner

Namrata Boveja

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 27-28 are presented for examination.
2. Upon review, the Examiner has determined Applicant's claim to priority back to 09/329,143, Patent Number 6,178,407, and to Patent Number 5,907,831 are invalid, since the specification for these related applications do not provide the necessary support for the disclosure and the claims presented in this case. Therefore, the claims will be given the filing date of 3/2/2004.

### ***Objections***

3. Applicant is required to submit a list of the original claims with (Cancelled) written next to the claim number for each claim the applicant is canceling and (Original) written next to the claims he is claiming in the original format. See 37 CFR 1.121. Appropriate correction is required.

### **Claim Rejections - 35 USC § 112**

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

4. Claims 27 and 28 are rejected under 35 U.S.C. 112.

Regarding claim 27, the phrase "capable of " renders the claim indefinite, because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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5. Claim 28 depends on claim 27, and therefore it is also rejected under 35 U.S.C. 112 for the same reasons above as claim 27.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 27 and 28 are rejected under U.S.C. 103(a) as being unpatentable over (article by Morton titled "e-Rewards Launches "By Invitation Only" E-mail Rewards Program" hereinafter Morton) in view of (article titled "Cybergold, Goldmail Aim to Change Net Ads Systems Pay Visitors to Read Ads, Collect Demographics in Return" hereinafter Cybergold Goldmail) and further in view of Official Notice.

In reference to claim 27, Morton teaches a method of providing advertisement to an advertising entity over a network, comprising: sending e-mail containing an advertisement message specifying a monetary value associated with the message (page 1 lines 11-17 and page 2 lines 26-32 and 37-43); and receiving a response from the user indicating that the user has opened the e-mail (page 1 lines 9-11 and 15-16 and page 2 lines 29-30 and 38-39). Morton also teaches rewarding credits for simply receiving the e-mails (before displaying or reading the e-mail) and additional credits for reading and responding to e-mails (page 1 lines 8-9 and 14-15, page 2 lines 28-29 and 38-40). Although Morton

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discusses accumulating e-Rewards and redeeming e-Rewards (page 1 lines 14-18), Morton is silent about transferring the monetary value specified in the e-mail to the account of the user. Goldmail, also an e-mail based rewards program, teaches paying users for advertisements and crediting the amount to a member's account (Cybergold Goldmail page 1 lines 21-22). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the transfer for monetary value into a user account to enable the user to keep track of accumulated points and to enable for easy redemption by the user.

Morton is also silent about displaying the monetary value before the user is capable of reading the advertisement. Official Notice is taken that it is old and well known to display a monetary value before the user is capable of reading an advertisement. For example, when a user signs up for a rewards program that gives points for receiving, reading, and responding to e-mails, the monetary value the user will receive for these various activities will be displayed for the user at the time of the user registration and before the user reads any e-mails sent out by the sponsor. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include displaying a monetary value before the user is capable of reading an advertisement so that the user would be aware of what the payout will be like for each of the activities, and so that the user can make sure he is receiving the appropriate monetary compensation associated with his response to various activities as specified by the program benefits.

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7. In reference to claim 28, Morton is silent about teaching the method further comprising specifying an expiration date after which opening the e-mail does not cause transferring of the monetary value to the user's account. Official Notice is taken that it is old and well known to specify an expiration date after which no transfer of monetary value takes place to the user's account. For example, when a customer tries to use a printed coupon at a drugstore, it will come up as being expired when the cashier attempts to scan this coupon as a result of the expiration code embedded in the UPC code associated with the coupon. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include specifying an expiration date after which opening the e-mail does not cause transferring of the monetary value to the user's account to prevent users from being rewarded for expired offers just like preventing users from being rewarded for expired manufacturer coupons at checkout.

### **Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) Eng. "To Earn Rewards, Just Hit the Site." Business Week. July, 8, 1996. Page 120l.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197.

NB

November 4<sup>th</sup>, 2005

  
RAQUEL ALVAREZ  
PRIMARY EXAMINER